Remarks

Claims 1, 5-16 and 18-20 are pending.

The "currently amended" status indicator for Claim 7 was incorrect in the response to the prior office action. The correct status indicator, "original", is included in the claim listing in this Response.

All pending claims were rejected under Section 102(e) as being anticipated by Howard (6823526). The Office carries the initial burden of establishing a prima facie case of anticipation. To meet this burden, the Office must show that the reference teaches "each and every element as set forth in the claim." MPEP § 2131 (quoting Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987)). "[A]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." See, e.g., Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1456 (Fed. Cir. 1984).

Calling Add-On Modules In Response To Initiation Of A Print Job

Claim 1 recites (1) receiving a call from the printer driver indicating that a print job is initiated, (2) determining whether any of the add-on modules are responsive to the call, and, (3) in response to determining that an add-on module is responsive to the call, connecting the responsive add-on module to the printer driver via the interface module. Claim 16 is a computer program product counterpart to the method of Claim 1 and recites similar limitations.

In the method of Claim 1, the actions relating to the add-on module are taken when a print job is initiated -- "receiving a call from the printer driver indicating that a print job is initiated." Howard does not teach that his add-on modules are called/implemented in response to the initiation of a print job. The Examiner's assertion to the contrary is not correct. Howard teaches that the driver configuration component "is modified in accordance with the add-on identifier key to include features associated with the optional feature component." Howard column 3, lines 22-24. The timing of this modification is not set out clearly in Howard. The pertinent passage in Howard is quoted below.

In step 85, the installer 22 installs the device driver 26 in the operating system 29. Ultimately, the device driver 26 operates the external device 30 based on the optional feature component 43. As the host system 20 and the external device operate to execute applications and instructions, the device driver 26 in step 90 (of FIG. 4B) searches for the add-on identifier key 23 in the registry 24. In step 95, the device driver 26 determines whether an optional feature, such as an envelope feeder for a laser printer, is included with the external device 30 by referencing the identifier key stored in the registry 24. The identifier key array 25.

For each add-on identifier key in the identifier key array 25, the device driver 26 in step 105 modifies the configuration settings component 27 based on the optional feature component 43. Before ending the add-on identifier sequence 100 in step 110, the configuration settings component 27 in step 105 is modified according to the add-on identifier key in the registry 24. Howard column 9, lines 43-59.

While it is possible that these actions are taken in response to the initiation of a print job, Howard does not explicitly teach that these actions are, in fact, taken in response to the initiation of a print job. The Examiner apparently argues at page 3 of the pending Action that this teaching is inherent in Howard because "printer drivers prepare documents for printing." Applicants disagree.

To establish inherency, the Examiner must show that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic <u>necessarily</u> flows from the teachings of the applied prior art. MPEP § 2112, paragraph IV.

The add-on modules in Howard implement in the device driver optional features of the device, such as an envelope feeder for a printer. Howard column 3, lines 4-6; see also Howard column 6, lines 4-11. Howard seems to suggest these optional features are added to the device driver when the driver is installed on the operating system of a host computer. Howard column 8, lines 57-58 and column 9, lines 43-44. Admittedly, Howard states in these same passages that "ultimately, the device [printer]

driver operates the device [printer] based on the optional feature...." Unfortunately, Howard does not tell us if "ultimately" means the optional features are added to the driver when the driver is installed or later when each print job is initiated. In view of the nature of the optional features in Howard, adding these features to the driver when the driver is installed would be more efficient (and therefore more likely) than calling them up each time a print job is initiated. Nevertheless, the important factor in the present discussion is that it is not necessary in Howard that the optional features be added to the driver in response to initiation of a print job. Howard, therefore, does not inherently teach calling an add-on module in response to the initiation of a print job.

For these reasons alone, Claims 1 and 16 and their respective dependent claims distinguish over Howard.

Inserting Data Or A Command Into The Print Stream

Claim 7 depending from Claim 1 (through Claim 6) recites the further limitation that the add-on module inserts data into the print stream. Clam 8 depending from Claim 1 (through Claim 6) recites the further limitation that the add-on module inserts a command into the print stream. Print stream is specially defined in the Specification as "the data stream constituting the print job as that data is transmitted through the printer driver 8, along with any overhead added to the print job at any point as it transits between the software application and the printing device 4." Specification page 3, lines 3-6.

The Examiner asserts that Howard teaches the further limitation of both Claim 7 and Claim 8 at column 6, lines 17-35. This assertion is not correct. It can be seen from the cited passage in Howard, quoted in full below, that there is no mention of a print job or overhead added to the print job generally, and more specifically, there is no mention of inserting data into the print job/overhead or inserting a command into the print job/overhead.

> In operation, the engine code element 35 searches the device hardware 38 for add-on features that are included for a specific external device 30 for connection to the host system (20). After determining those add-on features that are included and not included with that particular external device 30, the engine code element 35 prompts the i/o element 33 to access and scan the template 40. Specifically, the i/o element 33 scans the optional features component 43 for the input variables 44.

In effect, each input variable 44, "%", acts as a marker for enabling the i/o code element 33 to locate and insert data field values along the template 40. By scanning the template 40, the i/o code element 33 substitutes input variables 44 with data fields for included add-on features as well as nullifies input variables 44 for add-on features that were not included with that specific external device 30. By revising the template to include relevant add-on features, the i/o code element 33 formats the template into a resulting device id string. Howard column 6, lines 17-35.

The data field values discussed in these passages in Howard are added to a template 40 – template 40 is not part of a print job or overhead added to a print job. On the contrary, template 40 is registry used to add optional features to a device driver.

For these additional reasons, Claims 7 and 8 distinguish over Howard.

The foregoing is believed to be a complete response to the outstanding Office Action.

Respectfully submitted,

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